REMARKS/ARGUMENTS

In the first Office Action there was a formal antecedent expression drafting objection as to "airflow slot" in claims 1, 6, 7 and 8, which has been corrected by this amendment.

The first office action rejections of the *original* [now all extensively amended] claims were all 35 USC § 103 "obviousness" rejections. First, all of claims 1-7 on Malachowski 5,166,735 in view of Nakajima 5,520,382, and secondly, claim 8 further in view of Perez et al 6,565,081. As such, they are controlled by the following current MPEP Sections on § 103 rejections, which are respectively summarized and discussed here. Namely, MPEP § 2141, §§ 2144 - 2144.09 and § 706.02(j). In particular, according to MPEP § 706.02(j), a rejection based on 35 USC § 103 is authorized "where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references."

According to MPEP § 2141, when applying 35 USC § 103, the examiner must adhere to the basic tenets of patent law:

A. The claimed invention must be considered as a whole;

B. The references must be considered as a whole and must suggest the desirability of making the combination;

C. The references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention; and

D. Obviousness must be determined under a reasonable expectation of success standard.

In order to establish a *prima facie* case of obviousness, patent examiners are required to establish three criteria:

(1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

(2) There must be a reasonable expectation of success; and

(3) The prior art reference, or combination or references, must teach or suggest all the claim limitations.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.

It is not disputed that no one cited reference teaches or suggests the claimed invention, particularly as amended. These MPEP Sections and the law that they cite required an actual teaching or suggestion of their combination. It is agreed that the sheet transport system of Malachowski 5,166,735 is a different, apertured vacuum *belt*, sheet transport system with non-uniform vacuum pressure [even as little as is described therein in Col. 3 lines 58-60]. There is no suggestion of any kind of roller sheet transporting, much less "a plurality of sheet feeding rollers spaced apart along said sheet feeding path" with adjacent plural "airflow slots." The combined reference Nakajima 5,520,382 is to a completely different type of sheet transport, where, as shown and as recited in its Col. 2 lines 9-16:

> "According to the present invention, the above-mentioned problem is accomplished by a sheet transfer device comprising a sheet guide surface, and a fan having a fan rotor which draws air therein from a circumferential region thereof radially inwardly, said fan having .. a circumferential portion of said fan rotor projecting .. above said sheet guide surface,.."

Thus, not only is there no suggestion in either said combined reference to combine them, they teach away from one another, and both are so different from the present system that neither one suggests the claimed features of the claimed invention. The present invention does not have any of the above-recited structure or function of Nakajima 5,520,382 or Malachowski 5,166,735.

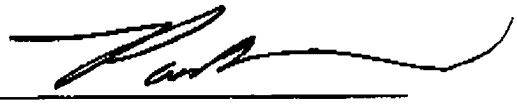
As to Claim 8, the additionally cited Perez et al 6,565,081 is not seen as contributing to the above attempted combination of references. Perez et al, like Nakajima 5,520,382 above, is a vacuum roller system that sucks air through a single, large, and apertured, roller provided with an internal vacuum, all of which features are directly and clearly distinguished by the present claims. That is very clear from the Perez et al specification and the air flow

arrows in Perez et al Figs. 5 and 6 [If the PTO better enforced proper patent drawing standards, Perez et al should not have issued with such drawings.]

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

A telephone interview is respectfully requested at the number listed below prior to any further Office Action, i.e., if the Examiner has any remaining questions or issues to address after this paper. The undersigned will be happy to discuss any further Examiner-proposed amendments as may be appropriate.

Respectfully submitted,



Paul F. Morgan
Attorney for Applicants
Registration No. 22,662
Telephone (585) 423-3015

PFM/gmm